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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,971	08/31/2001	Sridhar Sadasivan	83173HEC	2204

7590

01/29/2003

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EXAMINER

GRENDZYNSKI, MICHAEL E

ART UNIT

PAPER NUMBER

1774

3

DATE MAILED: 01/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS 3

Office Action Summary	Application No. 09/944,971	Applicant(s) SADASIVAN ET AL.	
	Examiner Michael E. Grendzynski	Art Unit 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2001 .
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 8/31/01 has been considered by the examiner.

Specification

2. In order to complete the specification, it is requested that applicants update the information of those applications listed in the Cross Reference to Related Applications section, as well as to those applications listed on pp 4 and 5.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-18 are rejected under the judicially created doctrine of double patenting over claims 1-18 of U. S. Patent No. 6431701 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A recording element comprising a ink-receiving layer including particles having a particle size of .04-5 μm and cationic particles comprising at least 20 mole percent of a cationic mordant moiety.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

5. Claims 1-18 are rejected under the judicially created doctrine of double patenting over claims 1-20 of U. S. Patent No. 6447110 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A recording element comprising a ink-receiving layer including particles having a particle size of .04-5 μm (40 – 5000 nm) and cationic particles comprising at least 20 mole percent of a cationic mordant moiety.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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6. Claims 1-18 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-20 of copending Application No. 09/944547. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: A recording element comprising a ink-receiving layer including particles having a particle size of .04-5 μm and cationic particles comprising at least 20 mole percent of a cationic mordant moiety.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

7. Claims 1-18 are rejected under the judicially created doctrine of double patenting over claims 1-20 of U. S. Patent No. 6447111 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A recording element comprising a ink-receiving layer including particles having a particle size of .04-5 μm (40 – 5000 nm) and cationic particles comprising at least 20 mole percent of a cationic mordant moiety.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

8. Claims 1-18 are provisionally rejected under the judicially created doctrine of double patenting over claim 1-20 of copending Application No. 09/943952. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

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The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: A recording element comprising a ink-receiving layer including particles having a particle size of .04-5 μm (40 – 5000 nm) and cationic particles comprising at least 20 mole percent of a cationic mordant moiety.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the phrase “at least about 20 mole percent” renders the claims ambiguous. One skilled in the art is unable to ascertain the lower threshold limit; consequently, the metes and bounds of the claims cannot be ascertained. It is suggested applicant delete the term “about” from the phrase.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asatake JP 11-180034)(JPO Machine Translation provided). Applicants claim an ink-receiving element comprising a substrate and an image-receiving layer thereon, wherein the image-receiving layer comprises (a) particles having a mean particle size of greater than 0.04 to about 5 μm and (b) water insoluble cationic particles comprising at least about 20 mole percent of a cationic mordant moiety. Asatake discloses a recording material comprising a substrate and an in-receiving layer. *See* Abstract. The ink-receiving layer comprises a latex polymer made having the formula $(A)_k(B)_m(C)_n$, wherein A comprises a cationic monomer (e.g., a quaternary ammonium salt) present in an amount of within applicants' claimed range ($k = 10-95$ mol %). *See* Abstract. This monomer is equivalent to applicants' cationic mordant moiety. The ink-receiving layer further comprises a matting agent such as silica or organic particles. *See* JPO Translation at ¶¶ 73-74. The matting agent is equivalent to applicants' claimed particle component. The matting agent particles, moreover, possess a particle size value within applicants' claimed mean particle size value. *See* JPO Translation at ¶ 76.

With regard to claims 3-5, Asatake discloses that its ink-receptive layer comprises a hydrophilic binder such as gelatin present within an amount claimed by applicants. It is also important to note that the phrase "up to about 20%" includes the value of zero (i.e., where no binder is present). *See* MPEP § 2173.05(c).

With regard to claim 10, examiner considers "about 1" μm to include the Asatake disclosed value of 3 μm .

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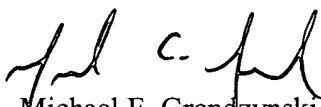
With regard to claim 13, the latex particles of Asatake possess a particle size value falling within the size value of applicants' water insoluble particles. *See Abstract.*

Conclusion

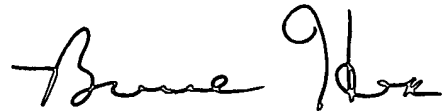
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Grendzynski whose telephone number is 703-305-0593. The examiner can normally be reached on weekdays, from 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.



Michael E. Grendzynski
Assistant Examiner
January 24, 2003



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